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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/981,339	10/17/2001	Gene Kelly Norris	A01062	5496

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EXAMINER
SZEKELY, PETER A

ART UNIT PAPER NUMBER

1714

DATE MAILED: 10/01/2004

Please find below and/or attached an Office communication concerning this application or proceeding.



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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 09/981,339
Filing Date: October 17, 2001
Appellant(s): NORRIS, GENE KELLY

Marcella M. Bodner
For Appellant

EXAMINER'S ANSWER

MAILED
OCT 01 2004
GROUP 1700

This is in response to the appeal brief filed 08/09/04.

(1) *Real Party in Interest*

A statement identifying the real party in interest is contained in the brief.

(2) *Related Appeals and Interferences*

A statement identifying the related appeals and interferences which will directly affect or be directly affected by or have a bearing on the decision in the pending appeal is contained in the brief.

(3) *Status of Claims*

The statement of the status of the claims contained in the brief is correct.

(4) *Status of Amendments After Final*

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) *Summary of Invention*

The summary of invention contained in the brief is correct.

(6) *Issues*

The appellant's statement of the issues in the brief is substantially correct. The changes are as follows: The new matter rejection of claims 1-6 and 9-18 has been withdrawn by the examiner because the "about 0.5" in canceled original claim 7 includes "greater than 0.5", Duvall et al. 2002/0086920 has been dropped as a reference and the 102 (a) rejections using Morton International EP 0 890 608 together with the 102 (e) rejection based on Duvall et al. 6,528,566 have been withdrawn by the examiner due to applicant's response.

(7) Grouping of Claims

Appellant's brief includes a statement that claims 1-6 and 9-35 do not stand or fall together and provides reasons as set forth in 37 CFR 1.192(c)(7) and (c)(8).

(8) Claims Appealed

The copy of the appealed claims contained in the Appendix to the brief is correct.

(9) Prior Art of Record

6,232,380	Conroy et al.	5-2001
6,528,566	Duvall et al.	3-2003
EP 890 608	Morton International, Inc.	1-1999

(10) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claim Rejections - 35 USC § 112

Claim 35 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The limitation, "from greater than about 12.5 wt% to 75 wt% of a mixture of zinc chloride and zinc carboxylate" cannot be found in the specification.

Claim Rejections - 35 USC § 102

Claims 1-6 and 9-35 are rejected under 35 U.S.C. 102(e) as being anticipated by Conroy et al. 6,232,380.

Conroy et al. disclose halogenated polymer and latent mercaptide in claim 1, Lewis acids and metal based stabilizers in claim 3, zinc soaps in claim 5, list of zinc soaps in column 18, lines 18-20, their concentrations in column 18, lines 26-28, list of Lewis acids, including zinc chloride, and their concentrations in the paragraph overlapping column 19 and 20 and combinations of metal based stabilizers with Lewis acids in column 20 lines 4-5. Epoxidized soybean oil is shown in the Examples and phosphites are mentioned in column 21, lines 14-28. Applicant's claims are not novel.

Claim Rejections - 35 USC § 103

Claims 1-6 and 9-35 are rejected under 35 U.S.C. 103(a) as being unpatentable over Conroy et al. 6,232,380.

The reference has been discussed previously. It would have been obvious to one having ordinary skill in the art, at the time the invention was made, to select the zinc chloride, which is a metal based Lewis acid, as the Lewis acid in combination with a zinc soap, in the latent mercaptide stabilized halogenated polymer composition or in the stabilizer package awaiting addition to a halogenated polymer.

Claims 1-18 and 35 are rejected under 35 U.S.C. 103(a) as being unpatentable over Morton International, Inc. EP 0 890 608 or Duvall et al. 6,528,566.

Morton International, Inc. recites polymer, mercaptan and a mixture of metal bases stabilizer and a Lewis acid in claim 1, zinc carboxylates in claim 3, zinc chloride

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in claim 4, PVC in claim 7, a stabilizer composition in claims 12-16, list of zinc carboxylates, Lewis acids and their respective concentrations and blends on page 9, lines 36-47, epoxy compounds and phosphites from page 10, line 56, to page 11, line 7. Duvall et al. teach polymer, blocked mercaptan, zinc chloride and zinc carboxylate with their concentrations in claims 1-6, a list of zinc carboxylates in column 10, lines 14-15, their concentrations in column 10, lines Lewis acids, including zinc chloride in column 10, lines 27-30, their concentrations in column 10, lines 31-34 and the combination of metal based stabilizer with Lewis acids in column 10, lines 34-36. Epoxy compounds are described in column 12, lines 36-55, phosphites in the column overlapping columns 12 and 13. It would have been obvious to one having ordinary skill in the art, at the time the invention was made, to select the zinc chloride, which is a metal based Lewis acid, as the Lewis acid in combination with a preferred zinc salt among the metallic based stabilizers, in the latent mercaptide stabilized halogenated polymer composition or in the stabilizer package awaiting addition to a halogenated polymer.

(11) Response to Argument

As far as the new matter rejection of claim 35 is concerned, the "greater than about 12.5 wt%" limitation and its significance are not present in the instant specification. The figure has been pulled out of thin air, for the sole purpose of circumventing the applied references. There is no statement or proof in the instant specification that applicant is in possession of every point, or in this case every 0.5 wt%, within the originally claimed range. In the case cited by applicant, e.g. in re Wertheim, there was a point (36%) near the claimed lower limit of 35%. There is no indication in the specification that applicant

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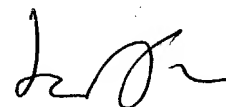
ever tested a stabilizer which had concentration limits even close to the claimed limitation. Conroy et al. 6,232,380 is valid prior art. The filing date of the patent is 11/25/98; its priority date is 5/10/95. Applicant's earliest filing date is 10/24/00. Conroy et al. has three inventors, Conroy, Norris and Duvall. The instant application has a single inventor, namely Norris. The inventive entities are not the same, thus the patent was issued to "others". Although several zinc salts and other metal-based stabilizers are named, a reference that clearly names the claimed species anticipates the claim no matter how many other species are named. Ex parte A, 17 USPQ2d 1716 (Bd. Pat. App & Inter. 1990). The claimed composition can be at once envisaged in spite the "may be used in combination" wording. The concentration ranges shown in column 18 and column 20 encompass applicant's claimed ranges. It is interesting to see that when arguing against the new matter rejection applicant relies on the encompassing argument, while in the case of anticipation he demands exactitude. Duvall et al. 6,528,566 and Morton International, Inc. EP 0 890 608 show the high end of the zinc carboxylate/zinc chloride concentration limitation as less than 0.5 wt% (Morton) or between 0.005% and 0.5% (Duvall), while applicant is claiming greater than 0.5 wt%. However the difference between 4.999999 wt% and 5.000001 wt% is extremely small. In Titanium Metals Corp. of America v. Banner, 778 F.2d 775, 227 USPQ 773 (Fed. Cir. 1985), the Court held that a *prima facie* case of obviousness exists where the claimed ranges and prior art ranges do not overlap but are close enough that one skilled in the art would have expected them to have the same properties. The improved results shown in Exhibit A and Exhibit B happen at a zinc chloride/zinc carboxylate blend

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concentration of 0.75 wt%, 1.0 wt%, 1.5 wt% and 2.0 wt%, not at 0.5000001 wt% or 0.51 wt% or even 0.6 wt%. As far as the multitude of metallic based stabilizers and Lewis acids are concerned, picking and choosing between different disclosed species may be entirely proper in the context of an obviousness rejection. In re Arkley, 455 F.2d 587, 172 USPQ 526 (CCPA1972).

For the above reasons, it is believed that the rejections should be sustained.

Respectfully,



Peter Szekely

Primary Examiner

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P.S.

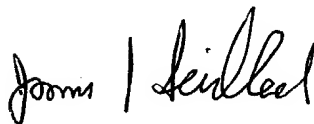
9/24/04

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